

Docket No.: 146392004900
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Letters Patent of:
Laura C. SIMMONS

Patent No.: 7,575,893

Issued: August 18, 2009

For: METHODS FOR PRODUCING HUMANIZED
ANTIBODIES AND IMPROVING YIELD OF
ANTIBODIES OR ANTIGEN BINDING
FRAGMENTS IN CELL CULTURE

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

On behalf of applicants, the undersigned requests reconsideration of the patent term adjustment indicated in the Issue Notification. This application for patent term adjustment is being filed within two months of the issue date of the present patent and is, therefore, timely. The fee required under 37 CFR 1.705(b)(1) as set forth in 37 CFR 1.18(e) is enclosed with the present application.

Correct Patent Term Adjustment

Applicants respectfully request a credit of 44 days be added to the 150 days of adjustment as indicated on the Issue Notification. The additional credit, minus applicants' delay, results in a revised total of 194 days of patent term adjustment.

Statement of Facts

According to the Office's Initial Determination of Term Adjustment received with the Issue Notification, mailed July 29, 2009, applicants are entitled to 150 days adjustment of patent term. Applicants disagree with the Patent Term Adjustment of 150 days and reconsideration is respectfully requested.

The Office failed to mail a notification under 35 USC 132 or a notice of allowance under 35 USC 151 within 14 months of the filing date of the present application. The Office correctly credits applicants 295 days of adjustment in accordance with 35 USC 154(b)(1)(A)(i) and 37 CFR 1.702(a)(1), 1.703(a)(1).

Applicants filed a Supplemental Information Disclosure Statement on October 2, 2006. The Office correctly calculates 60 days of applicants' delay in accordance with 37 CFR 1.704(c)(8).

Applicants filed a notice of appeal on April 17, 2007 in response to a final rejection, mailed December 18, 2006. The Office correctly calculates 30 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a Supplemental Information Disclosure Statement on August 31, 2007 after the filing of a Request for Continued Examination on June 15, 2007. Applicants calculate 77 days of applicants' delay in accordance with 37 CFR 1.704(c)(8).

Applicants filed a response on July 17, 2008 to a non-final office action, mailed March 21, 2008. The Office correctly calculates 26 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a supplemental amendment and response on February 26, 2009 to a final office action, mailed October 28, 2008. The Office correctly calculates 29 days of applicants' delay in accordance with 35 USC 154(b)(2)(C)(ii) and 37 CFR 1.704(b).

Applicants filed a Supplemental Information Disclosure Statement on June 17, 2009 after receipt of a Notice of Allowance, mailed April 8, 2009. Applicants calculate 21 days of applicants' delay in accordance with 37 CFR 1.704(c)(10).

The Office has failed to issue a patent within 3 years after the date on which the present application was filed (January 23, 2004). Based on an issue date of August 18, 2009, applicants are entitled to an additional credit of 142 days in accordance with 35 USC 154(b)(1)(B) and 37 CFR 1.702(b), 1.703(b).

Under the USPTO's Exclusion Interpretation of 35 USC 154(b)(2)(A) and application of 37 CFR 1.703(f) Actual Delay Limitation, the Office concludes that the 142 days of adjustment for failure to issue a patent within 3 years constitute "overlap" with the 295 days of adjustment for failure to issue an action within 14 months and thus, does not include the 142 days in the total calculation of term adjustment.

In light of Wyeth et al. v. Dudas, No. 07-1492 (D.D.C. September 30, 2008), applicants assert that the Actual Delay Limitation under 37 CFR 1.703(f) is no longer applicable and thus, the 142 days of delay under the 3-Year PTO Issue of Patent rule should be added to the 295 days of delay under the 14-Month PTO First Action rule.

Applicants calculate a total PTO delay of 437 days and applicants' delay of 243 days, for a revised total of 194 days of additional patent term. Based on the foregoing information, applicants respectfully request reconsideration of the patent term adjustment.

Conclusion

In the event the U.S. Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing Attorney Docket No. 146392004900.

Dated: October 16, 2009

Respectfully submitted,

Electronic signature: /Jian Xiao/
Jian Xiao

Registration No.: 55,748
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto, California 94304-1018
(650) 813-5736